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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,455	11/19/2003	Neng-Yu Tseng	JCLA12114	9847
23900	7590	12/22/2005	EXAMINER	
J C PATENTS, INC. 4 VENTURE, SUITE 250 IRVINE, CA 92618			NGUYEN, DONGHAI D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

Office Action Summary	Application No.	Applicant(s)	
	10/718,455	TSENG ET AL.	
	Examiner	Art Unit	
	Donghai D. Nguyen	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election of Species A, Claims 1-3, 7, 8, 10 and 11 in the reply filed on October 12, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 4-6 and 9 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-3, 7, 8, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation "solidifying the frame" (claim 1, line 8; claims 3 and 11; and claim 7, line 6) was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make or perform the step of solidifying the frame since it is

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uncertain as to whether the frame being liquid, gel, foam, or resin, etc material and how the frame is formed on the chip.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-3, 7, 8, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation recites: “attaching the substrate to frame on chip under a negative pressure” (claim 1, line 6-7 and claim 7, lines 4-5) is vague and indefinite because it is unclear as to whether all the attaching elements are under a negative pressure or only the chip; and further, the “solidifying the frame” (claim 1, line 8; claims 3 and 11; and claim 7, line 6) is incomplete since it is uncertain as to what material the frame made of and how the frame is formed in prior to the solidifying step.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 7 and 8 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,062,461 to Sparks et al.

Sparks et al disclose a frame attaching process comprising; forming the frame (18, see Fig. 2) on the active area of the chip (10), the frame surrounding the functional area (14); attaching the attaching surface of the transparent substrate (glass cap 12) to the frame formed on the active area of the chip under a negative pressure (see Col. 5, line 65 to Col. 6, line 2); and solidifying the frame (see Col. 5, lines 3-6).

9. Claims 1, 3, 7, 8 and 11 as best understood are rejected under 35 U.S.C. 102(a) as being anticipated by US Patent 6,635,941 to Suda.

Regarding claim 1 Suda discloses a frame attaching process adapted to attach an attaching surface of a transparent substrate to an active area of a chip using a frame, the active area of the chip comprising a functional area, the frame attaching process comprising; forming the frame (522 and 509) on the active area (516) of the chip (503), the frame surrounding the functional area (see Fig. 1C); attaching the attaching surface of the transparent substrate (light transmissive member 501 or 917) to the frame formed on the active area of the chip under a negative pressure (see Col. 9, lines 30-33); and solidifying the frame (by an ultraviolet light see Col. 6, lines 61-65).

The limitations of claims 3, 7, 8 and 11 also met as set forth above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 10 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over either Suda or Sparks et al.

Suda or Sparks et al does not disclose the specific operating range of atmosphere as recited in the above claims. It would have been obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to choose the negative pressure ranges from about 0.5 to about 0.9 atmospheres, since it has been held that finding an optimum values of a result effective variable involves only routine skill in the art. Further, it appears that the invention would perform equally with the atmosphere condition disclosed by either Suda or Sparks et al.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of references cited for their teaching attaching a substrate to a frame formed on the chip.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
December 14, 2005


MINH TRINH
PRIMARY EXAMINER